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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,054	01/26/2001	Richard A. Mallo	56147USA8A.002	7236

7590

08/26/2002

Attention: Yen Tong Florczak
Office of Intellectual Property Counsel
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EXAMINER

FUBARA, BLESSING M

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 08/26/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/771,054

Applicant(s)

MALLO ET AL.

Examiner

Blessing M. Fubara

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11 and 12 is/are rejected.
- 7) ☒ Claim(s) 9 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3,4,7. 6) ☐ Other:

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DETAILED ACTION

Examiner acknowledges receipt of IDS filed 02/26/01, 03/20/01, 05/07/01 and 04/29/02; corrected filing receipt filed 04/27/01 and response to election requirement filed 06/30/02.

Election Requirement

Applicants' election without traverse of ethylene glycol in claim 6, $\text{H}_2\text{NCH}_2\text{CH}_2\text{CH}_2\text{Si}(\text{OC}_2\text{H}_5)_3$ in claim 7, and the hydrophilic component in claim 10 where M is Na, m is 5 and n is 7 in Paper No. 8 is acknowledged.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 6-8, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Chang (US 3,941,733).

Chang teaches dispersions of poly(urethane-urea) terminated by hydrolysable or hydrolyzed silyl groups (abstract). The dispersion further comprises solubilizing groups which are groups that ionize in water such as carboxyl, sulfate sulfonate, phosphonate and quaternary ammonium compounds (column 3, lines 1-6). Isocyanate, specifically diisocyanate, polymeric polyol, silyl compound, e.g. X_3Si -compound, ethylene glycol polyfunctional chain extender, and water solubilizing compound react to form polyurethane-urea dispersions in water (column 3, line 14 to column 4, line 4 and column 6, lines 26-31). Terminal silyl groups are listed in

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column 7, lines 11-25 and all but one are clearly the silyl groups recited in claim 7 of the instant invention. Ammonium carboxylates are disclosed as water-soluble thermoplastic compounds (column 7, lines 49-65).

Regarding claim 1, the use of the composition in cosmetic application or hair composition is a future intended use and is not critical in a composition claim. Regarding claim 11, the polyurethane-urea polymer of the prior art would inherently have the self-adhesive properties of the composition of the instant invention and thus form a film that would have a thickness of 0.025 mm when coated and dried because the prior art teaches the composition of the instant invention.

Chang clearly teaches the limitations of the instant claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (US 3,941,733).

Chang clearly teaches a polyurethane-urea terminated by hydrolysable or hydrolyzed silyl groups but fails to teach the molecular weight of the polyol. Since Chang is silent on the molecular weight of the polyol, Chang teaches all molecular weights. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare composition of polyurethane-urea terminated by hydrolysable or hydrolyzed silyl groups and

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perform the chain extender reaction with polyols of all or any molecular weight because the silence in the prior art of the molecular weight of the polyol permits the use of polyol with any molecular weight. The use of a polyol that has a molecular weight in the range of about 200-5,000 is not inventive over the prior art in the absence of showing to the contrary.

5. Claims 9 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants' cooperation is requested in correcting any errors of which applicants may become aware in the specification including the claims.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is 703-308-8374.

The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Blessing Fubara
August 22, 2002


THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600